

REMARKS/ARGUMENTS

Claims 1-8 and 10-30 remain in this application. Claims 1 and 22 have been amended to specify that the shearing device is a blade.

I. Objection to Claim 1

Claim 1 has been amended to specify that the shearing device is a blade so as to be consistent with Applicant's amended claim language. In view of the amendment, the objection to claim 1 should be withdrawn.

II. § 102 and §103 Rejections

Applicant submits that claims 1 and 10 are not anticipated or made obvious by U.S. Patent No. 6,227,761 to Kieranen et al. (Kieranen). Kieranen does disclose or suggest a framework adapted to be **pulled behind** a prime mover, as claimed in claims 1 and 10. In fact, nothing is dragged behind base 22 of the prime mover of Kieranen. Accordingly, Kieranen in no way discloses or suggests a drag box, which is the invention claimed in claims 1 and 10.

In contrast, the contouring machine 20 of Kieranen has a contouring assembly 28 that is telescopingly mounted on the **front end** of the upper frame 40. See col. 5, lines 11-12, of Kieranen. Still further, the prime mover of Kieranen does not pull a framework so as to accommodate floating vertical movement of the framework independent of the prime mover, as claimed by Applicant in claims 1 and 10. Instead, when Kieranen's contouring apparatus is in use, platform 38 is securely planted at a desired location by four stabilizer legs 44. See col. 5, lines 8-10, of Kieranen. Accordingly, during the contouring process, the prime mover of Kieranen is not moving. Still further, boom 26 and support 27 of Kieranen do not allow contouring assembly 28 to have floating vertical movement, as allowed by the non-rigid connecting structure of Applicant's drag box that is claimed in claims 1 and 10. For the

foregoing reasons, Kieranen does not disclose or suggest all the elements in claims 1 and 10, and thus, claims 1 and 10 are not anticipated or made obvious by Kieranen.

Applicant further submits that claims 1-8 and 10-30 are not obvious over U.S. Patent No. 6,398,453 to Stegemoeller (Stegemoeller) in view of U.S. Patent No. 6,322,287 to Yelton (Yelton) and U.S. Patent No. 5,752,783 to Malone (Malone). Even if U.S. Patent No. 6,033,147 to Richter (Richter) is combined with Stegemoeller, Yelton, and Malone, claims 16 and 17 are not made obvious.

No Prima Facie Case of Obviousness Has Been Established

As the standard for assessing obviousness, MPEP 706.02(j) lists three requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103:

- (1) First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the references to arrive at the claimed invention.
- (2) Second, there must be a reasonable expectation of success.
- (3) Finally, the prior art references must teach or suggest all of the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure.

It is respectfully submitted that these three requirements have not been met. Therefore, Applicant respectfully submits that a *prima facie* case of obviousness for rejecting the pending claims has not been established. Claims 1-8 and 10-30 are not anticipated or made obvious by Stegemoeller in view of Yelton and Malone.

Referring initially to independent claim 1 and independent claim 22, Stegemoeller does not disclose or suggest a blade capable of shearing asphalt mounted on a framework, as claimed

by Applicant. Instead, as taught by Stegemoeller at col. 5, line 9, the strike-off assembly of Stegemoeller comprises a flexible screed. Further, Stegemoeller does not disclose or suggest at least one signal generator and at least one signal receiver associated with a proximity control device for activating the proximity control device in response to a signal emanating from the signal generator, as also claimed by Applicant in claim 1. In addition, Stegemoeller does not disclose or suggest a way to adjust the height of a blade with a proximity control device so that the blade is raised and lowered substantially instantaneously as the elevation of the surface being leveled changes, as claimed by Applicant in claim 22.

Yelton does not disclose or suggest a framework adapted to be pulled behind a prime mover, as claimed by Applicant in claims 1 and 22. In fact, Yelton does not disclose or suggest dragging anything behind a prime mover. Thus, Yelton does not disclose or suggest a drag box, as claimed in claims 1 and 22. Instead, the grading machine of Yelton includes a forwardly projecting frame that is in front of a small tractor. See the Abstract and Fig. 1 of Yelton. Accordingly, because nothing is pulled behind the prime mover, Yelton discloses no framework that is able to accommodate floating vertical movement independent of the prime mover, as also claimed by Applicant in claim 1. Still further, Yelton does not disclose or suggest at least one signal generator and at least one signal receiver associated with a proximity control device for activating the proximity control device in response to a signal emanating from the signal generator, as claimed by Applicant in claim 1. In addition, Yelton does not disclose or suggest a way to adjust the height of a blade with a proximity control device so that the blade is raised and lowered substantially instantaneously as the elevation of the surface being leveled changes, as claimed in claim 22.

Malone does not disclose or suggest a non-rigid connecting structure coupled with a framework for coupling the framework with a prime mover, as claimed by Applicant in claims 1 and 22. Instead, Malone's screed is pulled behind its paving apparatus using tow arms. Malone also does not disclose or suggest a proximity control device mounted on the framework being pulled, as claimed by Applicant in claims 1 and 22. Instead, the elevation of Malone's screed is adjusted via actuators 52 located on the prime mover that move tow points 51. Further, Malone does not disclose or suggest a blade being movable in a vertical plane independent of the prime mover, as also claimed by Applicant in claims 1 and 22. In contrast, by moving its screed through a tow point, Malone moves its screed in an arcuate shape rather than a vertical plane. Accordingly, Malone does not provide a framework that accommodates floating vertical movement independent of the prime mover, as claimed in claim 1.

Yelton's grading machine, which is located in front of a small tractor, is not properly combinable with Stegemoeller and Malone, which both disclose implements that are pulled behind a prime mover. Further, these references are not properly combinable because Yelton's grading machine is for moving aggregate not asphalt mixtures whereas Stegemoeller and Malone relate to distributing paving material. Accordingly, there is no reasonable expectation of being able to successfully combine Yelton with Stegemoeller and Malone.

Further, Stegemoeller is not properly combinable with Malone. There is no motivation from the cited references that the automated actuator of Malone located on its prime mover would be able to be adapted to control the hand jacks 54 of Stegemoeller's spreader box without using Applicant's invention as a template. Malone does not identify any deficiencies with his automated actuator on his prime mover so as to provide motivation that it would provide better control if attached directly to his screed. In fact, because of the weight and bulk of a screed, a

screed would need more support than provided by dragging it and using an actuator located directly on the screed for raising and lowering it. In addition, Stegemoeller does not provide any suggestion as to why a spreader box that merely distributes paving material across a surface would need to have automated actuator attached thereto. Stegemoeller is not teaching or suggesting leveling a surface and accounting for bumps and indentations in the road while distributing paving material, as done by Applicant. Instead, Stegemoeller merely teaches evenly distributing paving material across a road surface. In summary, there is no suggestion or motivation from Stegemoeller, Yelton, or Malone to modify what is taught by these references to arrive at Applicant's claimed invention without using Applicant's invention as a template.

Even if Stegemoeller, Yelton and Malone are combined, Applicant's claimed invention is not disclosed or suggested. The combination of Stegemoeller, Yelton and Malone does not disclose or suggest a blade mounted on a framework that is pulled behind a prime mover using a non-rigid connecting structure, as claimed by Applicant in claims 1 and 22. Further, the combination does not disclose or suggest a framework that is coupled with a prime mover so as to accommodate floating vertical movement independent of the prime mover, as claimed by Applicant in claim 1. Still further, nothing in the combination discloses or suggests raising or lowering the height of a blade substantially instantaneously as the elevation of a surface changes, as claimed in claim 22.

For the foregoing reasons, Applicant submits that independent claims 1 and 22 are not anticipated or made obvious by Stegemoeller in view of Yelton and Malone. Further, claims 2-8, 10-21, and 23-30 depend either from claim 1 or claim 22 and not anticipated or made obvious by these cited references for the same reasons claims 1 and 22 are not disclosed or suggested.

Still further, even if Richter is combined with Stegemoeller, Yelton, and Malone, claims 16 and 17 are not anticipated or made obvious. Richter merely teaches the thickness of an asphalt layer but does not teach or suggest what particular equipment would be compatible with the asphalt layers of the thicknesses he describes. Further, there is no teaching from Stegemoeller, Yelton, or Malone that their equipment is suited for being used on asphalt layers of the thicknesses described by Richter or claimed by Applicant. In fact, the screeds of Malone and Stegemoeller rather than shearing the asphalt mixture, as claimed by Applicant, would grab and pull at cold mix asphalt layers of the thicknesses claimed by Applicant. Furthermore, Yelton's tractor would drive over the asphalt layer after the grading machine was used leaving tire tracks in the freshly laid asphalt. For the foregoing reasons, claims 16 and 17 are not disclosed or suggested by the combination of Stegemoeller, Yelton, Malone, and Richter.

III. Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1-8 and 10-30 are in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, please contact the undersigned attorney at the number listed below. Acknowledgment of receipt is respectfully requested.

Respectfully submitted,

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